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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/801,832	03/17/2004	James G. Francis	1330.1020C	3139
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STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER NEWTON, JARED W	
			ART UNIT 3693	PAPER NUMBER
			MAIL DATE 01/06/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/801,832

**Applicant(s)**

FRANCIS ET AL.

**Examiner**

JARED W. NEWTON

**Art Unit**

3693

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2, 4, 5 and 7-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 5, 7-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

This final rejection is in reply to the response filed September 16, 2008. Claims 1, 2, 4, 5, and 7-16 are pending.

#### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 2, 4, 5, and 7-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Independent claims 1, 2, 4, and 7 are each directed to a method of handling transactions. For a method claim to fall within the statutory class of patent-eligible "processes," it must either (1) transform an article, or (2) be tied to a particular machine. In re Bilski, No. 2007-1130 (Fed. Cir. 2008). The claimed invention does not appear to transform an article. Furthermore, the claimed invention does not appear to be tied to a particular machine. The Examiner acknowledges language in the noted claims setting forth physical structure, or machines (e.g. "a consolidated computer database" in claim 1; "one or more computers" in claim 2; "a consolidated database" in claim 4; and, "an application database" and "consolidated database" in claim 7). This language, however, is deemed "insignificant post-solution activity" Bilski, at 16, and is not sufficient to bring the noted claims within the statutory requirements for subject matter eligibility pronounced in Bilski.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 4, 5 and 7-16 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent No. 5,890,140 to Clark et al. (hereafter Clark).

In regard to claim 1, Clark discloses a system and method for integrating global financial services, said method comprising: providing access to a transaction financier staff and to international commercial trade finance work items corresponding to the transaction financing and comprising issuances, advisements, amendments and payments at remote spoke user access locations (see FIG. 1, 12(1)-12(5); see also, claim 1); and processing, at a consolidated centralized hub processing location (see FIG. 1, item 10; see also, col. 5, lines 1-35), all the commercial trade finance work items across multiple bank organizations, which bank organizations are coupled to said remote locations (see e.g., col. 7, lines 1-41) and consolidating back office processing of the work items in real-time with constant processing availability (see e.g., col. 10, line 66 – col. 11, line 29) by using workflow routing between the locations as they become available for handling the work items and using a consolidated computer database in processing the work items (see e.g., col. 5, lines 17-35), the database having multiple

base currencies each base currency corresponding to a country source of the transactions (see e.g., col. 18, line 65 – col. 20, line 62).

In regard to claim 2, Clark further discloses accessing the international trade finance work items comprising issuances, advisements, amendments and payments, at remote spoke user access locations in different time zones (see Abstract); and providing back office processing of the work items across multiple bank organizations, across the different time zones in real-time using a consolidated computer database in processing the work item, the database having multiple base currencies, each base currency corresponding to a country source of the transactions at a single consolidated hub processing location having one or more computers coupled to said remote locations (see rejection of claim 1, above) .

In regard to claim 4, Clark discloses accessing, through a user interface, international trade finance work items comprising issuances, advisements, amendments, and payments to a transaction financier staff (see FIG. 1, 12(1)-12(5); see also, claim 1); and Processing, with Around-the-clock capability (see e.g., col. 2, lines 38-41), the work item across multiple bank organizations in real-time using a consolidated database in processing the work item (see col. 5, lines 1-35), the database having multiple base currencies by a single consolidated processing system.

In regard to claim 5, Clark further discloses work item processing is referenced to a global system time.

In regard to claim 7, Clark further discloses initiating execution of a business object at geographically distributed processing locations, each location including user

work stations having a trade finance interface (see e.g. FIG. 1, items 12(1)-12(5)); and performing, by an application server, back office trade finance business logic for processing international trade finance transactions across multiple bank organizations in real-time responsive to initiation by the work stations with constant processing availability using a consolidated database in processing (see col. 5, lines 1-35); the database having base currencies corresponding to country sources of the transactions, at a consolidated central processing location coupled to said distributed locations (see e.g., col. 18, line 65 – col. 20, line 62).

In regard to claim 8, Clark further discloses said business object as communicating with a consolidated database server for data required by the business logic (see col. 5, lines 1-35).

In regard to claim 9, Clark further discloses one of the workstations executing the business object (see e.g., col. 5, lines 36-40).

In regard to claim 10, Clark further discloses a communication object communicating between the interface and the business object (see e.g., col. 5, lines 1-36).

In regard to claim 11, Clark further discloses reassigning work items to the different locations responsive to time periods when those locations are operative (see Abstract).

In regard to claim 12, Clark further discloses the business logic as performed relative to a trade instrument identified on said interface, the trade instrument having a trade document associated therewith and said system further comprising an image

server storing an image of the document and a link to the instrument, allowing the interface to retrieve (see e.g., col. 18, lines 21-64).

In regard to claim 13, Clark further discloses connection and transport objects providing communication between said interface and said business object (see e.g., col. 2, line 34 – col. 3, line 32).

In regard to claim 14, it is inherent that the interface disclosed by Clark includes input output logic.

In regard to claim 15, Clark further discloses an object communication service requesting attribute values for fields of a window of said interface (see e.g., col. 20, line 65 – col. 21, line 60).

In regard to claim 16, Clark further discloses an attribute manager accessing an attribute object for an attribute of the business object (see e.g., col. 20, line 65 – col. 21, line 60).

**With respect to the above rejections, the Examiner has cited particular portions of the reference(s), and although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the Applicant consider each cited reference in its entirety as potentially teaching the limitations of the claimed invention.**

***Response to Arguments***

In view of the amendments filed September 16, 2008, the claim objections in the Office Action mailed April 16, 2008 are hereby withdrawn. Applicant is thanked for his corrections.

In view of the amendments filed September 16, 2008, the claim rejections under 35 U.S.C. 112, set forth in the Office Action mailed April 16, 2008 are hereby withdrawn. Applicant is thanked for his corrections.

Applicant's arguments with respect to the Clark reference, filed September 16, 2008 have been considered but are not persuasive.

Applicant first contends that the claimed invention is patentable over the Clark reference because "Clark is directed to providing customer access to financial services in real time," and that this is not the same as the claimed "processing... work items across multiple bank organizations." (Remarks, page 8, emphasis omitted). The Examiner agrees that Clark does indeed teach providing financial services to customers. But this fact does not preclude anticipation of the noted claim limitation. pursuant the providing of financial services, Clark teaches processing of transactions involving several items related to the different transactions. This processing anticipates the noted limitation. Furthermore, the claimed "processing," as would be understood by one of ordinary skill in the art at the time of the invention when given its broadest reasonable interpretation in light of the Specification would be anticipated by the Clark reference even if it were only limited to customer services. Applicant argues that "claim 1 provides the ability for workers of an organization to take advantage of differences in



working day hours of different countries." (Remarks, page 8). This limitation, however, does not appear in the claims.

Applicant further argues that Clark does not teach "constant processing availability." (Remarks, page 8). The Examiner maintains that this limitation is anticipated at least in columns five and six of the Clark reference, which provide: "The ... subsystems and components of the [global interface device of the present invention] can provide access to the electronic delivery system of the present invention 24 hours a day, 365 days a year. That is, a customer has access to the messages stored in the repository 24 hours a day, and can send instructions and inquiries to the GID 24 hours a day for immediate or delayed forwarding to the appropriate OLTPs ..." (col. 6, lines 18-25). Applicant argues that "the ability for the system in Clark to access back-end OLTPs is subject to the limitations of the OLTPs themselves because the client has to wait for 'normal operating hours.'" (Remarks, page 8). The "normal operating hours" of the various OLTPs, however, are irrelevant to the question of "constant processing availability." Like the instant invention, Clark's system takes advantage of geographically separated facilities so that transaction processing can occur at one facility when another facility may not be in operation. The result is a "system that can remain operable 24 hours a day, 365 days a year, to allow access to financial services at all hours of the day anywhere in the world. (Col. 2, lines 38-42).

Finally, Applicant argues that Clark does not teach "using a consolidated computer database having multiple base currencies each base currency corresponding to a country source of the transactions." (Remarks, pages 8-9). The Examiner maintains

that this limitation is anticipated by Clark's "library look-up list feature," which includes a catalog of the facilities included in the integrated system, and each facility's base currency. (Col. 19, lines 35-64).

In view of the foregoing, the rejections based on the Clark reference are maintained.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **JARED W. NEWTON** whose telephone number is (571)272-2952. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James A. Kramer/  
Supervisory Patent Examiner, Art Unit 3693

/J. W. N./  
for Jared Newton, Examiner of Art Unit 3693  
January 2, 2009